

No. 18442

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

WHAM-O-MFG. Co., a corporation,

Appellant,

vs.

PARADISE MANUFACTURING Co., a corporation,

Appellee.

On Appeal From the United States District Court for the
Southern District of California, Central Division.

BRIEF FOR APPELLEE.

WILLIAM C. BABCOCK,

G. MERLE BERGMAN,

712 Jergins Trust Building,

Long Beach 2, California,

Attorneys for Appellee.

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BRIEF FOR APPELLEE.

Jurisdictional Statement.

This is an appeal from the judgment of the District Court (Peirson M. Hall, D. J.) granting defendant-appellee's motion for summary judgment on Count I of the Complaint, holding the patent in suit invalid, and from the Order of the Court dismissing Count II, alleging unfair competition [R. 96-97, 100].

The District Court's jurisdiction over the subject-matter of Count I is based upon the patent laws of the United States, Title 28, U. S. C. Sec. 1338 (a).

The District Court's jurisdiction over the subject-matter of Count II is limited by Title 28, U. S. C. Sec. 1338 (b).

This Court's jurisdiction on appeal is based upon Title 28, U. S. C. Sec. 1291.

Statement of the Case.

The appellant herein originated this proceeding by filing a complaint against the appellee alleging patent infringement and unfair competition [R. 3-5]. The appellee denied both counts [R. 7-14].

The appellee filed a motion for summary judgment on the First Claim for patent infringement, asking the court to find the patent invalid for want of invention [R. 20-47]. The court determined that the subject matter of the patent in suit was obvious, and that the combination of a piece of plastic in common use with a soaker hose in common use did not change the function of these elements to bring about a new, surprising or unexpected result [R. 98-100].

Having found the patent invalid, the court reached the conclusion of law that there was no patent infringement [R. 100]. After granting the defendant's motion for summary judgment, the court, on its own motion, dismissed the Second Claim of unfair competition [R. 96-97].

In support of the appellee's motion for summary judgment the court had before it an affidavit of Mervyn B. Roberts, a copy of the patent in suit, copies of all prior art cited by the patent as well as that claimed by the appellee, and a drawing and copy of the alleged infringing device which was sold by the appellee [R. 24-47]. In opposition the plaintiff-appellant filed a Memorandum of Law [R. 86-88] but did not file any affidavits or exhibits. The appellant did, however, file a motion for summary judgment of its own, and in support thereof submitted an affidavit of Robert R.

Thornton and Arthur K. Melin and attached exhibits to the Thornton affidavit [R. 71-85]. This appeal was brought from the court's judgment and Order on the ground that there was a genuine issue of material fact, that the court had jurisdiction over the unfair competition claim which it had dismissed, that the court did not understand the patent in suit and could not, therefore, properly hold it invalid, and that it was error for the court to hold that the patent had not been infringed [R. 104-105].

Summary of Argument.

The court's conclusion that there were no genuine issues of material fact in this case was not predicated on the fact that both parties filed motions for summary judgment, but resulted rather from the plaintiff's failure to discredit the facts offered by the defendant or to suggest to the court some opposing facts which could possibly have the effect of changing the result.

The appellant offered no affidavits in opposition to the motion for summary judgment. Affidavits which it submitted in support of its own motion for summary judgment were not addressed to the question of validity, but to the question of infringement, and in so far as they touched upon matters of validity alleged no facts which contradicted the material facts alleged in the affidavit of the appellee.

The appellant's affidavit not only failed to contradict the appellee's affidavit on matters of fact relating to validity, but substantiated the appellee's case by affirmatively alleging that the Summers patent, which appellee claimed to be more pertinent prior art than that cited

by the Patent Office, was never called to the attention of the Patent Office by the appellant. Appellant presented no facts to the court which could have the effect of eliminating the pertinency of the Summers patent. The patent in suit failed to cite the Summers patent. Appellant's claim that there is an issue of fact over whether or not the Patent Office considered the Summers patent stems wholly from the erroneous assumption that the Patent Office is presumed to have considered it. On the contrary, the Patent Office is presumed not to have considered a patent which it fails to cite, where no evidence is offered to show that it had considered it.

The appellant argues that the affidavit of Mervyn B. Roberts and that of Robert R. Thornton offered conflicting facts on material matters. This is not so. Mr. Roberts' affidavit was addressed to the question of validity of the patent. Mr. Thornton's affidavit was addressed to the question of infringement of the patent. At no time did the appellant contradict any of the material facts alleged by the appellee. The issue of validity of the patent was a matter of law at the outset of the case, and it was not changed to an issue of fact by reason of an expression of opinion on that issue in the Roberts affidavit.

Where the claims of a patent are so simple that anyone of ordinary intelligence can understand them, the motion for summary judgment on the question of validity is particularly appropriate. Where no expert testimony is necessary the court can determine the issue of law as well on facts available to it on motion as it can after the most extensive array of evidence.

Since an invalid patent cannot be infringed, the court naturally concluded as a matter of law that it had not been infringed. Though this conclusion may be superfluous, it cannot constitute error.

In the absence of diversity of citizenship and allegations of interstate commerce, the sole source of jurisdiction over an action for unfair competition must rest upon the requirement of section 1338(b) 28 U. S. C., that the unfair competition cause be related to the claim of patent infringement. The test of a related claim urged by the appellant, and readily accepted by the appellee, is that a substantial amount of the evidence of one claim be related to the other. This test cannot be met where the devices actually sold by the parties embody different claims of the patent. In such a case, evidence tending to show that the defendant copied one or more of the patent claims while it may establish infringement, does not go to prove unfair competition. The essence of unfair competition is the copying of the article itself in order to palm off one's own article as that of his competitor. Thus, an action for unfair competition may prevail upon a showing that artistic design, trademark and packaging were copied, but this is quite different from the evidence necessary to show patent infringement. Only where the plaintiff's and defendant's devices are similar can the claim of patent infringement be related to the claim of unfair competition. But in this case the appellant admitted to the court that the "preferred" form of the patent was not used by the defendant. The court was certainly entitled to conclude that the plaintiff used what it called the "preferred" form and that the two devices were,

therefore, dissimilar in so far as the patent features were concerned. That they might be similar in design would be immaterial. The court was justified in concluding that the claims were not related and that it had no jurisdiction to hear the unfair competition cause.

The doctrines of commercial success and presumption of validity have no application where the invalidity of the patent is apparent on its face. Expertise is unnecessary to determine that a series of holes combined with a piece of ordinary plastic, to the end that water will be forced from the holes onto the plastic, is wholly lacking in invention. No court need presume that the Patent Office exercises any expertise in granting a patent on what is essentially a piece of wet plastic. The fact that a child may slide gleefully on wet plastic is not an unexpected result. It is an ordinary extension of the well known fact that an adult may slip and break his neck on it. The court properly declined to call this invention.

ARGUMENT.

I.

What Appellant Cites as Issues of Fact Are Matters Which Were Never in Dispute in the District Court, and Which Could Not Alter the Decision in This Case Even if They Favored the Appellant.

The appellant is correct in stating that the mere fact that both parties move for summary judgment does not establish the absence of an issue over a material fact. Certainly the court is required to examine the record before it to determine whether the record discloses a genuine issue of material fact, rather than to conclude that there is none simply because mutual motions for summary judgment have been filed. Nothing in the record of this case, however, indicates that the court failed to do its duty.

In *Gifford v. Travelers Protective Ass'n*, 153 F. 2d 209, 211 (C. A. 9th, 1946) this Court said:

“Where a defendant presents evidence on which it would be entitled to a directed verdict if believed and which the plaintiff does not discredit as dishonest, it rests on the plaintiff, in opposing defendant’s motion for summary judgment, at least to specify some opposing evidence which it can adduce and which will change the result.”

The appellant failed to point out to the court any evidence which might possibly change the result, and far from discrediting the defendant’s evidence as dishonest, presented evidence of its own which substantiated the defendant’s claim.

The appellant alleges (Appellant's Br. 14)

“that the Paradise motion, on its face, raised questions of fact as to whether the Summers patent was the most pertinent prior art and whether the Summers patent was considered by the Patent Office.”

The appellant then goes on to suggest that only for purposes of its motion for summary judgment did it concede that the Summers patent and lawn soakers patents were not considered by the Patent Office. But the court did not have to base its conclusions on concessions made by the appellant for purposes of its own motion. The court had sworn affidavits submitted by the appellant. On the basis of the record before it there was never any issue raised over the question of whether the Patent Office had considered the Summers patent. The only conclusion possible was that it had not, and there were no facts to challenge this conclusion.

The Summers patent was clearly not cited by the Patent Office [R. 44]. The appellant gave evidence of the classes which it caused to be searched and of the 24 specific patents in these classes which it found to be “pertinent” and which it called to the attention of the Patent Office [R. 72, 77], and the Summers patent was not among them. The appellant's attorney in his sworn statement [R. 72] alleged:

“I personally showed a copy of each of these patents to F. B. Leonard, an Examiner in Division 62 of the United States Patent Office, the Examiner in charge of the application; that the

aforesaid patents contained each of the patents referred to in Defendant's AFFIDAVIT OF MERVIN B. ROBERTS IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT, with the exception to (sic) United States Patent No. 2,314,525, issued March 23, 1943, to B. C. Summers, for Garden Hose Sprinkler; and the patents illustrated in the Roberts' Affidavit, with the exception of the aforesaid Summers patent, were also discussed with F. W. Varner, the Acting Primary Examiner of Division 62 of the Patent Office, to which division the application had been assigned."

The record, therefore, as the court saw it contained an affirmative allegation by plaintiff's counsel that he had never brought the Summers patent to the attention of the Patent Office [R. 72] coupled with the absence of any reference to the Summers patent in the patent in suit [R. 44]. On this latter point the appellant argues (Appellant's Br. 24):

" . . . the failure of the Patent Office to cite a patent does not, of itself, warrant a finding of fact, on motion for summary judgment, that the patent has not been considered, or that the patented structure has not been considered."

But this argument has never been accepted by the courts, and its weakness is clearly pointed out in the case of *Nordell v. International Filter Co.*, 119 F. 2d 948, 950 (C. C. A. 7th, 1941):

" . . . there can be no presumption of validity over this prior art which the Examiner did not

note. We are here confronted with a strange doctrine, that the fact that the Examiner did not mention this art raised no presumption that he did not see it and consider it. But on the other hand, appellees urge that it raises a presumption that the Examiner was aware of it and did not consider it applicable. We do not understand this to be the law.”

The same view is expressed in slightly different language in the case of *Himmel Bros. Co. v. Serrick Corporation*, 122 F. 2d 740, 745 (C. C. A. 7th, 1941). Clearly, the defendant is entitled to a presumption that the Examiner did not consider a case that he did not cite, where the plaintiff offers no affirmative evidence that it was ever considered. This presumption becomes all the stronger in the face of the plaintiff's own sworn statement that although many patents were called to the attention of the Patent Office the Summers patent was not among them.

The same presumption prevails with respect to lawn soakers generally. No lawn soakers were cited by the Patent Office as prior art [R. 44]. Nowhere in his affidavit does Mr. Thornton allege that lawn soakers were discussed with the Patent Office or considered by anyone in the Patent Office [R. 71-79]. In fact, by arguing as he did that the Rohmer patent, which merely showed the application of water to a sliding surface, was as good art as the Summers patent for contesting validity of the patent, he made it quite clear that lawn soakers had not been considered by the Patent Office [R. 72 and 119]. If they had been considered he would not have had to cite the Rohmer

patent. While it is quite true, as appellant argues, that the Summers patent is much more complicated than the ordinary lawn soaker, and offers an increased wear-resistant, metal area as its principal feature (Appellant's Br. 21), it is a patent which is suggestive of the lawn soaker. Naturally, the lawn soaker itself is unpatentable, since it consists of nothing more than a flexible conduit with holes punched in it. But the Summers patent is as close as you can come to a lawn soaker and still obtain a valid patent. Now that it has expired, and ever since its issuance, the area of patentability has become all the more limited.

It is clear that the appellant offered nothing to the court to refute the presumption that neither the Summers patent nor lawn soakers of any kind were considered by the Patent Office. The argument that the Patent Office must have considered lawn soakers because they are common enough for the Patent Office to take notice of them without the necessity of citing them [R. 119], is without merit. The question is not whether the Patent Office could have taken "administrative" notice of lawn soakers, but rather whether it did. There was no evidence offered to that effect.

As pointed out in *Gomez v. Granat Bros.*, 177 F. 2d 266, 268 (C. A. 9th, 1949), any presumption of validity which might otherwise attach to the issued patent is destroyed when pertinent prior art is not considered. This is particularly so when the pertinent prior art has been so long in the public domain that notice can be taken of it without the necessity of consulting documents or hearing evidence.

Appellant would argue that the question of what is the most pertinent prior art is a fact issue. But the *Gomez* case, just cited, illustrates how readily the court will treat it as a matter of law where expert opinion is unnecessary to explain its features. Clearly when no expert opinion is necessary a judgment as to prior art is nothing more nor less than a judgment as to patentability. Whether something is patentable and whether a patent is valid is undeniably a question of law. In *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801 (C. A. 9th, 1957) this Court made that point emphatically and cited Mr. Justice Douglas in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 155, 71 S. Ct. 127, 132 (1950) as follows:

“The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law.”

The appellant would have us look at the Roberts affidavit to find in it some ground for reversal (Appellant's Br. 18). But a glance at the Roberts affidavit only serves to confirm the court's judgment on the motion. The affidavit contains several allegations of material fact which went unchallenged by the plaintiff.

There is an allegation that for the past twenty years the affiant had been able to purchase on the open market all of the components of the plaintiff's alleged invention [R. 24]. The plaintiff did not deny this.

The Roberts affidavit attached the Carrier patent as an exhibit [R. 41]. The plaintiff did not dispute the fact that this was a true copy.

The Roberts affidavit attached a drawing of the defendant's device as an exhibit and alleged that the plastic which went into the construction of that device had been used in other products prior to the filing date of the patent in suit [R. 26]. The plaintiff did not deny this.

The Roberts affidavit alleged that the affiant was acquainted with lawn soakers prior to the date on which the patent in suit had been filed, and that the result obtained by the plaintiff's device could also be obtained by laying one of those lawn soakers alongside a piece of the plastic that he alleged he had used for other articles prior to the date of filing of the patent in suit [R. 26]. The plaintiff did not deny this.

In short, none of the facts alleged by the defendant in support of its motion for summary judgment were ever placed in issue by the plaintiff.

But the appellant would argue that this is a case where there are conflicting opinions of expert witnesses, and therefore summary judgment is inappropriate (Appellant's Br. 19). This statement is predicated on the proposition that the Roberts and Thornton affidavits offered conflicting "expert" opinions to the court. The only opinions ventured by Mr. Roberts were, as the appellant points out (Appellant's Br. 19), conclusions of law. Mr. Roberts opined that the patent was invalid. The expression of this opinion could do nothing more than relieve Mr. Roberts of an apparently irresistible urge to express the obvious. It was of no help to the court whatever, and it is not to be presumed that the court substituted Mr. Roberts' opinion

for its own. Mr. Thornton, on the other hand, opined very little if any on the validity of the patent, but opined at some length on the matter of infringement [R. 73-75]. There was, therefore, no conflict between the two affidavits. One addressed its facts and opinions to validity, whereas the other addressed them to infringement.

In so far as each urged upon the court what he considered to be the proper interpretation of the patent, neither of the affiants functioned as expert witnesses. Neither of the affidavits dealt with technical patent language which the court could not understand without their assistance, because there was none. A boy scout would not be entitled to a merit badge for crossing the street in company with a policeman, merely because he chose to call the policeman "blind." And likewise, a witness does not become an expert witness merely because he chooses to consider the court blind and offers assistance that is not needed. Under the teaching of *Hurin v. Electric Vacuum Cleaner Co.*, 298 Fed. 76, 79 (C. C. A. 6th, 1924) a witness who merely expresses his opinion on the proper interpretation of the patent is not an expert witness, and that is all that these affiants really did when they departed from the presentation of facts.

The appellant did not dispute facts alleged by the appellee in the court below, and certainly presented its case on the assumption that the prior art was so simple, and the claims of the patent so simple, that the court

could compare these on their face. The appellant should not now argue otherwise. As was said in *Park-In-Theatres v. Perkins*, 190 F. 2d 137, 142 (C. A. 9th, 1951):

“There are cases in which factual presentation is necessary to make clear the significance of the patent either because of conflicting interpretations of its claims or because the patent, in its nature, is difficult to understand. But there are other cases where there can be little doubt what the patent claims and factual presentation is not necessary to illuminate the alleged invention.”

Clearly, this is one of the “other cases,” where factual presentation is unnecessary. Accordingly, any dispute over facts, if it existed, would be irrelevant. It is of no consequence whether the Patent Office did or did not consider the most pertinent prior art if the matter of validity can be determined on the face of the patent itself. As will more particularly appear under the discussion of Point IV, *infra*, a presumption of validity cannot prevail in the face of obvious invalidity. The facts which the appellant considers in dispute have bearing only on the presumption of validity. Summary judgment was resorted to by the appellee to save both parties the necessity of proving facts which in final analysis could not alter the outcome of the case. As was said in *Park-In-Theatres*, just cited, “Judicature is a practical business and the summary judgment procedure has been introduced into our practice as a practical device for the expeditious disposition of litigation where there appears to be no need for the usual type of trial.”

II.

Where a Patent Is Invalid There Can Be No Infringement, and Even Though It Be on Motion for Summary Judgment and Facts May Be in Dispute on the Question of Infringement, a Ruling of the Court That There Is No Infringement Cannot Constitute Prejudicial Error.

The appellant contends (Appellant's Br. 38-39) that there is no factual basis for a finding of non-infringement. Appellant concludes that if the holding as to patent invalidity is improper, the ruling on infringement must be disapproved. The appellee agrees, and undoubtedly the District Court would agree.

The court's conclusion that there was no infringement was not a finding of fact on the merits, but a conclusion of law resulting from the invalidity of the patent.

There is no inconsistency between the case of *The Diversey Corporation v. Charles Pfizer and Co.*, 255 F. 2d 60 (C. A. 7th, 1958) and *Bergman Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801 (C. A. 9th, 1957), both cited in appellant's brief at page 38. Both cases acknowledge that where a patent is invalid it cannot be infringed. The *Bergman* case merely indicates that it is not necessary for a court to express this truism in its Findings and Conclusions of Law, but the case certainly does not stand for the proposition that any error is committed if the court sees fit to put the obvious into words. There can be no error grounded on the court's holding that the patent is not infringed, if the patent is indeed invalid.

Appellee agrees that the appellant would be entitled to try the issue of infringement if the Court were to reverse the judgment of invalidity. But in the absence of any such reversal, no error can be predicated on the trial court's conclusion of law that the patent was not infringed.

III.

The District Court Lacked Jurisdiction Over the Claim of Unfair Competition, Since There Was No Diversity Jurisdiction, No Allegation of Interstate Commerce Which Might Bring It Within the Rule of *Stauffer v. Exley*, and the Claim Was Not Related to the Claim of Patent Infringement.

This Court, in *Stauffer v. Exley*, 184 F. 2d 962, 964-966 (C. A. 9th, 1950), discussed at length the circumstances under which the federal courts, in the absence of diversity jurisdiction, have jurisdiction over an action for unfair competition. The pleadings disclose that diversity jurisdiction does not exist in this case [R. 2].

The *Stauffer* case is particularly well known for the enunciation of a proposition, not widely followed by other Courts of Appeal, that sections 1337 and 1338(a) of Title 28 U. S. C., confer upon the federal courts jurisdiction over actions for unfair competition which are unrelated to any other cause in the complaint, where the unfair competition is alleged to affect interstate commerce. Since there are, in this case, no allegations regarding interstate commerce [R. 2-6], it is clear that the appellant cannot rely upon this ground for jurisdiction.

The only remaining ground which might have application to this case would be Title 28 U. S. C. 1338(b) which gives the federal courts jurisdiction over a claim of unfair competition when it is joined with a substantial and related claim under the copyright, patent or trademark laws.

Since the copyright and trademark laws are not involved in this case, our inquiry is narrowed to the question of whether the claim of unfair competition is joined with a substantial and related claim under the patent laws.

The appellant is of course right in stating the law to be that the mere fact that a patent is held to be invalid does not in and of itself make the patent claim unsubstantial. There has to be some evidence that the patent claim was in fact asserted for the purpose of bringing the unfair competition claim into the federal courts, rather than for the sake of succeeding on the patent claim itself. This follows from the fact that, unlike copyright, letters patent carry a presumption of validity. The patentee, therefore, is presumed to be in good faith when he brings suit under a patent which has been formally issued to him, and the mere fact that a court may find the patent invalid does not serve to destroy this presumption of good faith. Since there have been no facts introduced in this case to suggest that the appellant acted in bad faith when suit was instituted under its patent, the appellee must agree with the appellant that its patent claim is entitled to be regarded as "substantial" within the meaning of the statute in question.

But the appellee is satisfied that the decision of the District Court in dismissing the Second Claim on its own motion was correct, inasmuch as the claim of unfair competition is not related to the patent claim. In making this statement, the appellee readily accepts the liberal standard which the appellant would have us apply to the term "related."

The appellant's counsel, in addressing the court on the motion for summary judgment, indicated that the defendant's device and the plaintiff's device were dissimilar in so far as their patent features were concerned [R. 120-121]. He said:

"Strictly speaking, your Honor, in the patent, if you will look, the holes are preferably formed by a stitching, whereas in the defendant's device they are actual holes in a sealed conduit. . . ."

Now counsel, of course, went on to point out to the court that the less preferred method adopted by the defendant was also covered by one of the claims in the patent, but for the purposes of this inquiry we are only concerned with the fact that he conveyed to the court the information that the preferred structure was not the structure used by the defendant. The court was certainly entitled, and indeed compelled, to infer from this that the plaintiff's device embodied the form which appellant's counsel considered preferable. No other conclusion could be reached.

The court was, therefore, entitled to regard as an undisputed fact the dissimilarity in the patent features of the plaintiff's and defendant's devices. Since unfair competition is the attempt to palm off one's product as another's by simulating features of the other's

product, *Haeger Potteries, Inc. v. Gilner Potteries*, 123 Fed. Supp. 261 (D. C. S. D. Calif., 1954), it is at once apparent that the simulation, if it exists, does not exist in so far as the patent claims are concerned. It may exist as far as design features are concerned without there being any similarity in patent features. The plaintiff did not bring suit on a design patent, but on a mechanical patent, and admitted to the court that the mechanical features of the plaintiff's and defendant's devices were dissimilar.

It is apparent, therefore, that evidence which the plaintiff might offer to show similarity between the defendant's device and one or more of the patent claims, which goes to prove patent infringement, would not prove unfair competition. To support its claim of unfair competition the plaintiff would have to offer evidence of similarity in design, which is unpatented, and similarity in packaging and in mark, together with evidence that these similarities were the result of deliberate copying for the purpose of deceiving the public as to their origin. None of this evidence is pertinent to the patent claim.

This precise problem was involved in the case of *Algren Watch Findings Co., Inc. v. Kalinsky*, 197 F. 2d 69, 70 (C. A. 2d, 1952), where instead of a mechanical patent as here, the patent pleaded was a process patent. The court pointed out that the unfair competition claim was related to design and was not related to the process patent which had been pleaded. The court said:

“We find no error in the dismissal of the plaintiff's claim for unfair competition. At best that

charge amounted to nothing more than that the defendant manufactured a buckle similar in design to that of the plaintiff. We cannot see that that act of unfair competition was in any way related to the claim for infringement of the process patent, see 28 U.S.C.A. §1338(b), and therefore are of the opinion that the trial court properly dismissed the former claim for want of jurisdiction. Moreover, the plaintiff concedes that it has no patent on the buckle itself, and it is quite well settled that the copying of an unpatented design does not per se constitute unfair competition.”

Since the appellant has not pleaded any design patent, and has admitted that the mechanical features of its device and that of the defendant's are dissimilar, the court was entitled to conclude that the appellant could not sustain its action for unfair competition by substantially the same evidence that would be offered to prove its claim of patent infringement. Since it could not show similarity in mechanical features it would be obliged to offer evidence of similarity in design, packaging, and mark to support its claim of unfair competition. None of these is involved in the patent claim. Thus, even accepting the “liberal” standard set in *Maternally Yours v. Your Maternity Shop*, 234 F. 2d 538, 544 (C. A. 2d, 1956), cited by the Ninth Circuit in *Pursche v. Atlas Scraper and Engineering Co.*, 300 F. 2d 467 (C. A. 9th, 1962) as one of the cases holding that it is sufficient if a substantial amount of the evidence of one claim be relevant to the other, the District Court had no jurisdiction of the claim of unfair competition. None of the material evidence of-

ferred to prove patent infringement would relate to the claim of unfair competition, since the devices were dissimilar in their patent features. The District Court properly ruled that it was without jurisdiction to hear the claim of unfair competition, and did so on its own motion only after it appeared from the plaintiff's own admission that the causes were not related. Moreover, in this case the invalidity of the patent stems from a constitutional jurisdictional defect rather than a purely statutory one, so that the Court would have no jurisdiction even if the claims were related.

IV.

Commercial Success and Presumptions of Validity Are Not Adequate Substitutes for Invention, and the Legal Doctrines Which Have Grown Up Around Them Do Not Require a Court to Uphold the Validity of a Patent Which Is Obviously, Indisputably, and Notoriously Lacking in Invention.

If, as we are told in *Koepke v. Fontecchio*, 177 F. 2d 125 (C. A. 9th, 1949), Rule 56 of the Federal Rules of Civil Procedure was designed to spare the parties the trouble and expense of a trial where the outcome is not subject to doubt, it is particularly well suited to dispose of the case at hand.

The appellant would only postpone the inevitable, and subject both parties to unnecessary trouble and expense, if he were successful in invoking legal doctrines which hold that commercial success is a fact evidencing invention and that the issuance of a patent carries with it a presumption as to its validity. Neither

of these propositions is disputed by the appellee, but commercial success is but a single fact evidencing invention and neither it nor the presumption of validity which attaches to a patent upon issuance can dispose of other more compelling facts and presumptions which establish lack of invention.

The appellant's eloquence cannot alter the fact that he has been granted a patent on a piece of ordinary plastic and some holes. What evidence could possibly convince any court that it is invention to attach a garden soaker to a piece of plastic?

The appellant argues (Appellant's Br. 34) that if the invention were obvious to one skilled in the art it would have been made long before the filing of the patent in suit. But there is such a thing as something being *too* obvious. The commercial appearance of such an item is long delayed because people generally conclude that if it had any commercial possibilities it would have been marketed long before. There can be little doubt that that is the situation in this case. Commercial success in this modern age does not necessarily depend on invention. Merchandising opens more doors to commercial success than invention. The financial genius of this day is one who determines in advance what the public will buy, and gives it to them in a package they will buy at a price they will buy. If it is still true today that commercial success is a fact evidencing invention, it is certainly a fact which has become enfeebled with advancing years.

Two men watching a boy sliding on a piece of old plastic which he has deposited on the ground and wet down with a garden hose, may both observe that the

operation would be more efficient if the boy did not have to stop and wet the plastic after each use. Both might observe that if a garden soaker were attached alongside the piece of plastic the boy could slide without having to stop each time to wet the plastic. But one of them might conclude that the combination was so simple and obvious that it would have been made long ago if it had any commercial future, whereas the other might know enough about indulgent fathers to realize at once that he had only to attach the garden soaker to the piece of plastic to make a fortune. This insight does not make the second man an inventor. It makes him only a shrewd judge of how limitless is the power of a child in inducing his parent to buy him something he could just as well do without. The courts can give him his due by labelling him a commercial genius. They should not be obliged to call him an inventor. As was said in *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 328, 65 S. Ct. 647 (1945):

“He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge.”

That commercial success in this case does not herald invention is all the more apparent when we direct our attention to what the appellant considers the patentee

has invented. The appellant's counsel pointed out [R. 120-121] the "inventive" portion of the patent in these words:

"Strictly speaking, your Honor, in the patent, if you will look, the holes are preferably formed by a stitching, whereas in the defendant's device they are actual holes in a sealed conduit. Now this feature is also described in the patent . . .

"And it is also described that you can apply the water to the surface by putting holes, making a folded over sealed seam and putting holes in the conduit, which is the way that it is done in the defendant's device."

Thus, out of the mouth of counsel we find that the appellant owns a patent on various styles of holes! He explains that one hole is made by "stitching" and the other hole by "putting." Counsel complains that the defendant has stolen his client's "putting" hole. Now this is not the first time that this Court has ruled on the inventiveness of holes. It did so in *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 809 (C. A. 9th, 1958) where it said:

"The drain slot * * * forms the basis of this invention,' the inventor has told us.

In other words, his patent is built upon a foundation even less substantial than sand. It is constructed upon a slot—in other words upon a *hole*.

Such a patent cannot stand. At most, it 'is merely a mincing step forward.'"

But in this case the inventor claims to have done something more than invent a hole. He has discovered that when a flexible piece of plastic is folded up it can be stored and easily carried! The appellant severely criticizes the District Court for failing to observe this, and suggests that the court's failure to recognize this feature of the patent demonstrates its inability to understand the nature and extent of the patent (Appellant's Br. 27). The appellant points out that claim 1 reads in part, "said strip being of a selected thickness, flexibility and weight so as to conform to irregularities of the ground when extended and when in storable condition to provide for the facile carrying thereof by a user." The appellant further points out that the court, in describing the teachings of the patent refers only to a strip which is flexible enough to conform to ground irregularities. This, according to the appellant, constitutes a material oversight which demonstrates the court's inability to cope with the patent claims.

The patent does not disclose the ideal thickness and weight for the plastic to be flexible enough to conform to ground irregularities and when in a storable condition permit "the facile carrying thereof by a user." Nor does it prescribe the optimum length. The patent relies on the knowledge of the user to select a piece of plastic suitable for the use to which it is to be put. Any school boy selecting a piece of plastic to slide on knows enough to choose one that will hug the ground and will not be larger than he can carry. Moreover, it is virtually impossible to find a flexible piece of plastic that would not be easy to carry when folded and still serve the purpose which the patent suggests.

Yet, when the court describes the plastic in terms of its purpose and flexibility to conform to ground irregularities, rightly considering the “facile” carrying to be too obvious for words, the appellant points to this as striking evidence of the court’s failure to comprehend the patent claims.

A poet is expected to take poetic license, and by the same token, lawyers are expected to split hairs. But hair splitting must be an art that serves a purpose. It must help to illuminate a difference of substance, not form. The difference which the appellant has seized upon to discredit the court’s judgment is only the shadow of a difference. It is no help to the appellant that this is not a shadow cast from the frail body of misunderstanding, as the appellant would urge, but rather one which results from the enduring body of human experience.

The appellant would find further fault with the court’s description of the teachings of the patent because the court describes the patent as one teaching a flexible water conduit connected to one side of a flexible strip. The appellant points out that a rigid conduit could be used if it were attached to one end of the elongated strip rather than to the side, and that this is what is described in claim 3. But throwing sand to create the illusion of a desert can avail the appellant nothing. The preferable form is obviously a flexible conduit along the side. A rigid conduit at either end would be a hazard and would not wet the plastic as well as a flexible conduit along the side. It is, therefore, not a likely form to be adopted. Moreover, the defendant’s device, which the plaintiff claims infringes

the patent, has a flexible conduit along the side [R. 45-46].

Suffice it to say that the appellant purports to find a basic difference between the language of the court in describing the teachings of the patent, and the language of the patent itself. The appellant concludes from this that the court did not understand the patent, and that its ruling of invalidity is therefore in question. It is for this Court to determine whether the appellant's conclusion is a fair one to reach, but in defense of the court the appellee would argue that its language is admirably suited to describe the patent in suit, and has omitted nothing of substance.

However adroit the appellant may be in pleading for inventiveness of the patent in suit, it cannot seriously be doubted that whether the device has a flexible conduit or a rigid conduit, and whether it be easily carried or not easily carried, it is nothing more than a piece of plastic with the simplest kind of water soaker attached. When the Patent Office issues a patent on what, in use, is essentially nothing more than a wet piece of plastic, no court is obliged to indulge in the presumption that the patent is valid.

As far back as 1883 the courts were denouncing the practice of issuing patents on such items. Mr. Justice Bradley in *Atlantic Works v. Brady*, 107 U. S. 192, 200, 2 S. Ct. 225 (1883) uttered the following expression of policy:

“The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes

a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

It is quite true that the appellant, by attaching the garden soaker to the piece of plastic, made an improvement over the combination of these two parts used separately. But the improved result does not change the function of these parts. They are the same as when they were used separately by the boy next door. Even if it might be said that the appellant preceded the boy next door in using wet plastic to slide on, this new use is not invention. Before the turn of the century in *Lovell Mfg. Co. v. Cary*, 147

U. S. 623, 637, 13 S. Ct. 472 (1893) the Supreme Court listed a whole array of cases and then said:

“The principle deducible from these cases is that it is not a patentable invention to apply old and well known devices and processes to new uses, in other and analogous arts.”

Similarly, this Court, in *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 806 (C. A. 9th, 1957), after commenting pointedly on Mr. Justice Douglas’ “caustic ‘list of incredible patents which the Patent Office has spawned,’ ” which he set out in the *Great Atlantic & Pacific* case cited above at page 12, observed that the “Use of some special but well-known material does not constitute invention.”

It is clear, therefore, that this case does not fall within the purview of the court’s comments in *Hughes Blades, Inc. v. Diamond Tool Associates*, 300 F. 2d 854 (C. A. 9th, 1962), cited by appellant in its brief at pages 17-18, where genuine issues of fact remained to be decided. It is rather within the area of expression in *Rankin v. King*, 272 F. 2d 254, 258 (C. A. 9th, 1959), where the court said:

“. . . it appeared clearly as a matter of law from the undisputed facts . . . and the prior art patents both cited and non-cited, that the patent in suit was invalid because of want of patentable novelty.”

It is well established that where the prior art and the patent claims are so simple that any ordinary person, without the aid of expert testimony, can understand them, the motion for summary judgment is the

proper method of disposing of the case. In *Glagovsky v. Bowcraft Trimming Co.*, 267 F. 2d 479, 480 (C. A. 1st, 1959) this universal proposition was summed up as follows:

“The prior art and the patent claims are so simple that they can be readily understood by any normally intelligent person without the aid of expert testimony. There was, therefore, no error below in disposing of the plaintiff’s suit on the motions for summary judgment and their supporting affidavits, depositions and exhibits.”

In that case, as here, the plaintiff argued that the invention was proven by commercial success, that it carried with it a presumption of validity, and that the burden of establishing invalidity rested on the defendant. Speaking at page 482, the court dealt with these contentions in the following manner:

“The plaintiff’s advance may well be useful and ingenious. But making full allowance for the presumption that the patent is valid and placing the burden of establishing its invalidity on the defendant, 35 U.S.C. §282, it does not seem to us that even in the light of the plaintiff’s commercial success it can be said that the plaintiff’s contribution, viewed either against the background of the allied prior arts . . . or against the background of the particular prior art . . . can be called an invention without defining that term to describe no more than the sort of advance to be expected from any ordinarily skillful mechanic conversant with any of the arts involved.”

As suggested by the following quotation from *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 330, 65 S. Ct. 647 (1945), legal doctrines such as long felt want, commercial success, presumptions of validity and so forth, have no bearing in a case such as this where doubt does not exist:

“Finally, petitioner claims . . . a long felt want and . . . commercial success. But these considerations are relevant only in a close case where all other proof leaves the question of invention in doubt. . . . Here the lack of invention is beyond doubt and cannot be outweighed by such factors. Moreover, there is an absence in this case of any long felt want or of any recognized problem that had baffled the contemporary art.”

A Court of Appeals case decided a few years later states even more emphatically the view that legal doctrines, such as those relied on by the appellant, have no place in a case of this kind. The court in *Minnesota Min. & Mfg. Co. v. Industrial Tape Corp.*, 168 F. 2d 7, 11 (C. C. A. 7th, 1948), certiorari denied 335 U. S. 829, 69 S. Ct. 56, said:

“In affirming the lower court’s holding of invalidity, we are not unmindful of the presumption which attaches to the patent grant. We are convinced, however, that such presumption has been clearly overcome in the instant matter. We have also taken note of the commercial success attributed to the patentee’s device and that defendant discarded its own type dispenser and adopted that of the plaintiff. *Argument predicated upon these premises, however, is beside the point unless the court is in doubt on the issue of validity, which we are not.*” (Emphasis added)

It is clear, therefore, that the interpretive rules regarding commercial success, presumption of validity, burden of proof, and so forth, have grown up to assist the courts in deciding close cases. They tip the scales on the side of the patentee where the balance is so perfect that either side may be right. But they do not serve to add anything to the patentee's case where no doubt lingers. They are a featherweight that can tip the scales when they are evenly balanced, but they blow away with the slightest breeze on a scale heavily weighted against the validity of the patent. The presumption of validity upon the issuance of a patent cannot prevail where the commonplace features of a patent are so obvious that expertise is unnecessary. We shall never know what prompted the Patent Examiner to issue a patent on a series of holes and a piece of flexible plastic, both of which were in the public domain. But we should not compound the magnitude of this error by pretending that the Patent Examiner has an expertise in holes and flexible plastic that this Court does not possess. This Court can take judicial notice of the size and variety of holes, and of the various uses to which flexible plastic may be put, and having done so, can indulge in no other presumption than that the Patent Examiner, in issuing the patent in suit, was experiencing a malaise, common to all men, which sometimes impairs the ability to function in one's usual efficient and logical manner. In so doing, the Court does not disapprove of the presumption of validity which attaches to a patent when issued, but reserves that presumption for the cases in which it properly applies.

Conclusion.

There was no error in the judgment and Order of the District Court.

The plaintiff presented no material facts to the court over which there may be said to have been a genuine dispute on the matter of validity of the patent.

The patent was invalid on its face and the presumption of validity and legal doctrines relating to commercial success and burden of proof cannot serve to change or postpone this conclusion of law.

The court rightly dismissed the claim of unfair competition on its own motion when it appeared from certain admissions of the plaintiff's counsel that the claim of unfair competition was not related to the patent claim, since the proof offered in one claim would be substantially different from that offered in the other.

The decision of the court below should, therefore, be affirmed, with costs awarded to the appellee on this appeal.

Respectfully submitted,

WILLIAM C. BABCOCK,

G. MERLE BERGMAN,

By G. MERLE BERGMAN,

Attorneys for Appellee.

Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that in my opinion, the foregoing brief is in full compliance with those rules.

G. MERLE BERGMAN

